

DETAILED ACTION

Information Disclosure Statement

The IDS of 27 July 2009 has been considered. The fee for consideration of a complete IDS after a non-Final Office action without certification has been charged.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-6 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-073959.

This rejection was presented in the last Office action. As noted in the response, the limitations of claims 1, 2, and 7 have been combined as independent claim 3. Additionally, the amounts of the wax from the specification have been added to claim 3. Various dependencies have been modified because of these changes and new claims 10-12 have been added. The reference is discussed again, below, as it relates to the claims now presented.

The JP document discloses in Example 1 a toner comprising a mixture of 100 parts styrene-butyl acrylate polymers, 8 parts of a nitrile butadiene rubber (i.e., a thermoplastic elastomer; see spec. ¶ [0019]), a magnetite (a color pigment), 2 parts of a polypropylene (identified as a wax component in the specification), and a nigrosine charge control agent (¶ [0014], [0056] – [0062]). The ratio of the binder resin to the elastomer is 100/8 (or 92.6/7.4 as expressed in the claims). The polypropylene is identified as a wax in ¶ [0031] – [0033] where low molecular weight polyolefins are identified as waxes. Polypropylene is also disclosed as a

wax in the specification in ¶ [0032]. The polypropylene in reference Example 1 does not correspond to any other class of component and, thus, would be understood by the artisan as a wax. The polypropylene wax in the example is present in an amount of 2 parts per 190 parts of the toner solids or can be expressed as 1 weight percent of the toner solids. The artisan would also immediately envisage using any of the disclosed waxes in reference passage of ¶¶ [0031] – [0033] in the same amounts as the polypropylene because the polypropylene corresponds to the “mold-release” compounds of the reference and the artisan would use any of the disclosed compounds in the specifically disclosed amounts.

Other types of elastomers can be used, such as a polyester or polyamide elastomer (¶¶ [0014]; see Examples 2 and 3). Other useful binder resins include styrene copolymers polymerized with monomers, such as ethylene (¶¶ [0022] – [0024]). Various colorants can be used to form a color toner (¶ [0052]). Because the nitrile butadiene is preferred thermoplastic elastomer in the instant specification (¶ [0019]) it appears it would inherently have a melting point within the range of pending claim 5. Further, because styrene butyl-acrylate are preferred monomers for (A1) and (A2) in the instant claims (see spec. ¶¶ [0013] and [0014]) it appears that the claimed ratio of Ma/Mb in pending claim 6 would be inherently present in the reference toner. The toner of the reference examples are prepared by themselves and meet the requirements of a one-component developer. These one-component developers would be non-magnetic when the disclosed non-magnetic colorants are used in the toner. The recitation in claim 8 of the toner as being “for developing electrostatic charge images by a non-magnetic one-component developing method” is an intended use and does not positively limit the claims.

In response to applicant's traversal that the JP document does not disclose the amount of wax as currently claimed (response p. 7). As discussed above, the JP document identically discloses the amount of the wax as claimed. Consequently, the advantages discussed on

specification pages 7 and 8 would inherently be present in the JP document because a material and its properties are inseparable.

The rejection is still seen as proper and is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-073959.

The JP document was discussed above and the findings of fact are incorporated here. In the event the reference's disclosure of polypropylene in the examples does not identically disclose a wax, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the disclosed waxes in ¶¶ [0032] & [0033] in the amounts disclosed in the examples for the polypropylene. The polypropylene serves as a release agent, as do the waxes, and the use of disclosed materials for their known purpose in amounts disclosed as useful for that function would have been obvious to the skilled artisan. The evidence of record has been considered but is not effective because it does not compare with the applied art. Further, the evidence is narrower in scope than scope of the claimed toner, particularly with respect to components (A) and (B). Consequently, the evidence is not effective to overcome the rejection.

Conclusion

Those rejections and objections not repeated are withdrawn based on applicant's amendments.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 6:00 to 4:30 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/
Primary Examiner
Art Unit 1795

15 October 2009